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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/549,852

09/23/2005

Hans-Peter Buchstaller

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EXAMINER

CHU, YONG LIANG

ART UNIT

PAPER NUMBER

1626

MAIL DATE

DELIVERY MODE

07/16/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/549,852	Applicant(s) BUCHSTALLER ET AL.	
	Examiner Yong Chu	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 1-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33 is/are rejected.
- 7) ☒ Claim(s) 33 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>06/05/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-33 are pending in the instant application.

Information Disclosure Statement

Applicants' Information Disclosure Statement, filed on 06/05/2006, has been considered. Please refer to Applicant's copy of the PTO-1449 submitted herewith.

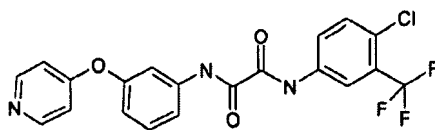
Priority

This application is a 371 of PCT/EP04/02406 filed on 03/09/2004, and claims the benefit of EP Patent Applications 03006702.9 filed on 03/24/2003.

Response to Lack of Unity

Applicants' election without traverse of the new Group of claim 33 and elected

species of compound (2)



on page 77 of the

specification in the reply filed on 04/27/2007 is acknowledged.

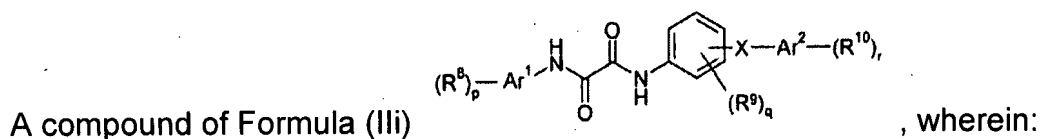
Status of the Claims

Claims 1-32 are further withdrawn from further consideration by the Examiner as being drawn to non-elected inventions under 37 CFR 1.142(b) due to the restriction requirement.

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Elected and Examined Subject Matter

The scope of the invention of the elected subject matter and the examined subject matter is as follows:



Ar¹ is phenyl; **Ar²** is pyridinyl; **X** is -O;

R⁸ is H, Hal, and C(Hal)₃; **R⁹** is H or alkyl; **R¹⁰** is H, Hal, and C(Hal)₃;

p, r is independently from one another 0, 1, 2, 3, 4 or 5;

q is independently from one another 0, 1, 2, 3, or 4, and

Hal is F, Cl, or Br, or pharmaceutically acceptable salts thereof.

As a result of the election and the corresponding scope of the invention identified supra, claims the remaining subject matter of claim 33 are withdrawn from further consideration pursuant to 37 CFR 1.142 (b) as being drawn to non-elected inventions. The withdrawn compounds contain varying functional groups, which are chemically recognized to differ in structure, function, and reactivity.

Specification

The first paragraph of the specification does not contain continuing data to which the instant specification claims benefit from. An appropriate amendment is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 33 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "The compound according to claim 3, comprising formula Iii" is indefinite, because it is not clear how to define the compound by the open-end transition phrase "comprising", thereby rendering the scope of the claim(s) unascertainable. It is suggested to replace with "The compound of formula Iii".

Claim 33 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "the pharmaceutically acceptable derivatives" is indefinite, because it is not clear how to define the "derivative", thereby rendering the scope of the claim(s) unascertainable. It is suggested to delete it unless there is a well-defined term for the compounds.

Claim Rejections - 35 USC § 102(b)

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

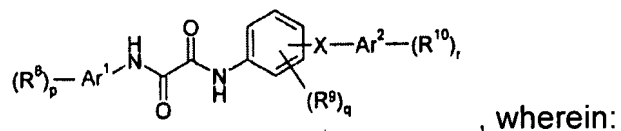
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

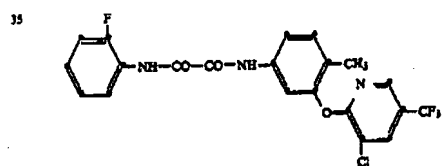
Claim 33 is rejected under 35 U.S.C. 102 (b) as being anticipated by Boger et al., U.S. Patent No. 4,656,183 (the '183 patent).

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Applicants' claims relate to a compound of Formula (Iii)

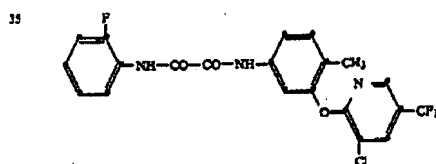
**Ar¹** is phenyl;**Ar²** is pyridinyl;**X** is -O-;**R⁸** is H, Hal, and C(Hal)₃;**R⁹** is H or alkyl;**R¹⁰** is H, Hal, and C(Hal)₃;**p, r** is independently from one another 0, 1, 2, 3, 4 or 5;**q** is independently from one another 0, 1, 2, 3, or 4, and**Hal** is F, Cl, or Br, or pharmaceutically acceptable salts thereof.

The '183 patent (published on 04/07/1987) discloses the compound 35 (CAS RN



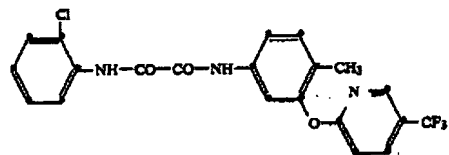
98500-24-4)

in columns 17-18, compound



6(CAS RN 98499-96-8)

in columns 11-12



, and the other compounds listed in columns 9-28.

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Therefore, the prior art teaching anticipates the instant claim.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 33 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of copending Application No. 10/563,830. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 4 claims compounds of formulae IIa-IId containing the same core structure as the instantly claimed compounds.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Objections

Claim 33 is objected to for containing elected and non-elected subject matter.
The elected subject matter has been identified supra.

Conclusion

- Claim 33 is objected.
- Claim 33 is rejected.

Telephone Inquiry


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Chu whose telephone number is 571-272-5759. The examiner can normally be reached between 7:00 am - 3:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Yong Chu, Ph.D.
Patent Examiner
Art Unit 1626

KAMAL A. SAEED, PH.D.
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